

Appl. No. 09/933,782
Amendment and/or Response
Reply to Office action of 8 October 2004

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REMARKS

Claims 1-25 are pending in this application.

The applicant respectfully requests the admittance of this amendment, to place the claims in a better condition for allowance or appeal. The applicant respectfully suggests that this amendment adds no new matter, and does not require an additional search.

The Office action rejects claims 1 and 8-15 under 35 U.S.C. 101. The applicant respectfully traverses this rejection.

The Examiner asserts that if an invention might also be implemented using pencil and paper, the invention is non-statutory. The applicant respectfully disagrees with this interpretation of 35 U.S.C. 101, and respectfully requests the Examiner review of MPEP 2106.

Of particular note, MPEP 2106 states:

"a complete definition of the scope of 35 U.S.C. 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent."

The applicant notes that MPEP 2106 does not refer to "any new and useful process *that cannot also be implemented using pencil and paper*", as the Examiner suggests. The applicant further notes that many computer related inventions, such as those related to simulation, searching, gaming, and so on, might also be implemented using pencil and paper. For example, MPEP 2106 specifically recites a process that the applicant suggests might also be implemented using pencil and paper:

"Claims drawn to a long-distance telephone billing process containing mathematical algorithms were held to be directed to patentable subject matter because "the claimed process applies the Boolean principle to produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle." *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999);

Because the applicant claims a new and useful process, the applicant respectfully requests the Examiner's reconsideration of the rejection of claims 1 and 8-15 under 35 U.S.C. 101.

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The Office action rejects claims 1-10 under 35 U.S.C. 102(e) over Suzuki (USP 6,313,745), at page 3, paragraph 7. However, the cover sheet to the Office action cites claims 1-25 as being rejected, and claims 11-25 are addressed in the remarks following the cited rejection. The applicant traverses this rejection, and assumes that the rejection over Suzuki applies to claims 1-25.

The Examiner's attention is requested to MPEP 2131, wherein it is stated:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 claims a method of providing a recommendation to a user for a recommended piece of clothing from an inventory of apparel of the user, for use by the user, comprising maintaining a clothing profile of the user, including the inventory of apparel and preferences of the user, detecting a piece of clothing being selected from the inventory and updating the clothing profile based on said selection, generating the recommendation for the recommended piece of clothing from the updated clothing profile, and providing the recommendation to the user.

Suzuki does not teach detecting a piece of clothing being selected from the user's inventory, as specifically claimed in claim 1.

Claim 2, upon which claims 3-7 depend, claims a system for generating a recommendation to a user for a recommended piece of clothing from an inventory of apparel of a user, for use by the user, comprising: a user profiling unit that is configured to maintain a clothing profile of the user, including the inventory of apparel and preferences of the user, one or more sensors that are configured to detect a selected piece of clothing being selected from the inventory, coupled to the database for updating the clothing profile based on the selected piece of clothing, a recommendation unit that is configured to generate the recommendation for the recommended piece of clothing from the updated clothing profile, and a rendering system that is configured to present the recommendation to the user.

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Suzuki does not teach one or more sensors that are configured to detect a selected piece of clothing being selected from the user's inventory, as specifically claimed in claims 2-7.

Claim 8, upon which claims 9-10 depend, claims a method of presenting a targeted clothing advertisement to a user, comprising obtaining a clothing profile for the user, determining a clothing product that matches the clothing profile, and sending an identifier of the clothing product to the user.

Suzuki does not teach sending an identifier of a clothing product that matches a user's clothing profile to a user, as specifically claimed in claims 8-10.

Claim 11, upon which claims 12-15 depend, claims a method of presenting a recommendation of an ensemble to a user, comprising: maintaining an inventory of apparel possessed by the user, determining one or more subsets of apparel from the inventory suitable for forming the ensemble, and presenting at least one of the one or more subsets of apparel to the user.

Suzuki does not teach determining one or more subsets of apparel from a user's inventory suitable for forming an ensemble, as specifically claimed in claims 11-15.

Claim 16, upon which claims 17-25 depend, claims an apparel recommendation system comprising: an inventory system that is configured to maintain an inventory of apparel possessed by a user, a processor that is configured to identify one or more subsets of apparel in the inventory suitable for forming an ensemble, and a display that is configured to present at least one of the one or more subsets of apparel to the user.

Suzuki does not teach a processor that is configured to identify one or more subsets of apparel in a user's inventory suitable for forming an ensemble, as specifically claimed in claims 16-25.

Because Suzuki fails to teach at least one claimed limitation in each of the applicant's claims, the applicants respectfully request the Examiner's reconsideration of the rejection of the applicant's claims under 35 U.S.C. 102(e) over Suzuki.

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In view of the foregoing, the applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the present application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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